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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/462,550	03/14/2000	TREVOR JOHN BURKE	P-5695	5213

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EXAMINER

KOSTAK, VICTOR R

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 09/05/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/462,550

Applicant(s)
Burke

Examiner
Victor R. Kostak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other: _____

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1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Note MPEP 606.01.
2. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to the drawings, each of the lettered items should appear in upper case, without underling or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-Reference to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc (see 37 CFR 1.52(e)(5)).
- (e) Background of the Invention.
 1. Field of the Invention.

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2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.

- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (I) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing, if on paper (see 37 CFR 1.821-1.825).

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set

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forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means"

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and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. Claim 3 is objected to because of the following informalities: the claim must end with a period (it currently ends with a comma). Appropriate correction is required.

5. Claims 1-20 provide for the use of program generation, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. *A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.*

Claims 1-20 are accordingly rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). See also *Ex parte Erlich*, 3USPQ2d 1011 at 1017.

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 12-14, 16, 17 and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshimura et al. (EP 0705036, cited and provided by applicant).

The television system of Yoshimura (noting particularly Fig. 10) receives an MPEG formatted data stream (col. 16 lines 46-47), whereby a given program is edited such that each program is first designated according to its genre (Yoshimura develops his description using a music program as an example), which is then further segmented into elements designated as classification items and detail items which are assigned ID data (e.g. Abstract) by the head end. The programming is downloaded with the ID codes and stored (note various storage in Figs. 10, 11 and 14), which enables a user to thus access a program in which specific classification and detail items can be extracted using the classification (ID) codes for display of only those items, thereby accommodating the user with a customized display sequence based (col. 14 lines 9-19; col. 17 lines 17-25; col. 18 lines 44-45), and thereby meeting claims 1, 12 and 21.

As for claim 2, the reference type of event, in the example given by Yoshimura, can be the presentation of a specific singer.

As for claim 3, each program element is classified by a subjective assessment (i.e. by movie, type of movie; musical, music group members: note Figs. 2-8).

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Regarding claim 4, the classification and detail items (i.e. program elements) are automatically selected according to predetermined criteria, namely according to the ID codes assigned each element.

As for claim 5, the user initiates the downloading of the selected programming and detail items, using, for example, remote controller 90.

As for claims 13 and 14, the system of Yoshimura can operate such that only a selected subset of the program elements are transmitted to and stored the receiver (col. 4 line 56 - col. 5 line 15; col. 5 line 32 - col. 6 line 8; col. 7 lines 14-26).

Considering claims 16, 17 and 22, the receiver of Yoshimura inherently functions in a manner which displays each received (and/or stored) data segment faster than it takes the data segment to be transmitted to the receiver, or else the image sequence would not be intelligible (it is pointed out that a principle design consideration of video communication requires real-time display rate of the received video stream regardless of any lag in reception).

As for claim 20, the predetermined control data is the received and decoded header data (inherent in each packet frame) which controls the synchronization/timing of the data to be displayed.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al.

Although Yoshimura does not specify that the stored program segments are combined with the received program elements, it would have been clearly obvious to one of ordinary skill in the art to present the entire program to the user if he so wishes, in the instances when the user decides to view the complete program rather than just segments, or in instances when another members of the household prefer to watch the entire program.

8. Claims 6-11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al. in view of Nagasaka et al.

Although Yoshimura does not specify using icons to represent the elements or items, he does state that the user can designate items using a search key from a list table M4 according to color designations (col. 31 lines 49-58), which suggests to one of ordinary skill in the art to use any suitable display representation to assist in identifying respective items. In view of this explicit suggestion and in view of the very similar receiver of Nagasaka, who in fact uses designated icons for identifying program elements (col. 13 lines 52-54), it would therefore have been obvious to one of ordinary skill in the art to incorporate any suitable display assistance, such as icons as taught by Nagasaka, for the clear purpose of being more user friendly, thereby meeting claims 6 and 19.

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As for claims 7 and 8, Yoshimura describes the order of display being selectable by the user (col. 32 line 1+), which would involve symbols as taught by Nagasaka.

Regarding claim 9, it would have been obvious to present the program segments simultaneously to the viewer for the purpose of enabling ready identification for selecting which segments to expand on or dismiss (provision of a variety of display options being a typical consideration of the system designer), as shown by Nagasaka (Figs. 9, 17).

As for claim 10, both Yoshimura and Nagasaka present the accompanying audio with the video segments (as most programming does).

As for claim 11, as noted above, a primary consideration in designing user selectable A/V programming is in offering as much variety of display options as possible (to thereby accommodate as large a range of tastes and to provide as much control to the user as possible). The related system of Nagasaka includes simultaneous display of the real-time program and still images representing the program segments (Figs. 9 and 17). It would have been obvious to include this display option in the system of Yoshimura as taught by Nagasaka for the clear benefit of providing the user with additional display options which provide the user with ready information to advance the selection process, by displaying information simultaneously.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al. in view of Heiman.

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Ensuring that the data transmitted is at least adequate (if not error free) is a normal consideration in the communication field since various negative influences exist in the general environment. Various measures are typically implemented to counter such effects, including retransmission of packets, if necessary, when MPEG data is transmitted, as taught by Heiman (col. 4 lines 17-22; col. 7 lines 3-6). It would have been clearly obvious to incorporate suitable error correction/avoidance measures such as retransmission of packets, in the MPEG communication mode of Yoshimura, to thereby provide adequate data communication.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is informed that of the additional references cited, Yeo and Newman appear the most relevant to his claimed system.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor R. Kostak whose telephone number is (703)-305-4374. The examiner can normally be reached on Monday through Friday from 6:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile, can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone (703) 306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231


or faxed to:

(703) 872-9314 (For either formal or informal communications intended for entry. For informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Victor R. Kostak

Primary Examiner



VRK

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